

Application No. 10/803,482

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REMARKS

Responsive to the Restriction Requirement dated June 9, 2006, Applicants elect, with traverse, Group I, Claims 1-18 and 23.

The Restriction Requirement sets forth three groups. Group I, Claims 1-18 and 23, is directed to compounds; Group II, Claims 19-21 and 24-63, is directed to a method of using the compounds of Group I to inhibit gene expression and treat disease; and Group III, Claim 22, is directed to a diagnostic method.

The Examiner asserts that the inventions of Groups I and II are properly restricted because "the methods can be performed with the use of different compounds." The products referred to in support of the restriction requirement include insulin and "commercially available diet pills." While it may be true that obesity, for example, can be treated with a commercially available diet pill, this fact does not support the Examiner's restriction requirement. MPEP Section 806.05(h) states that restriction between a product and its use is proper, *inter alia*, where the method *as claimed* can be practiced with a materially different product. A method of treating obesity by administering a commercially available diet pill is not the method *as claimed*. The methods *as claimed* require the administration of a compound of Group I. That is, the products used in the method *as claimed* are *identical* to the products of Group I. Because the method *as claimed* cannot be practiced with a *materially different* product from the products of Group I, the stated test set forth in MPEP Section 806.05(h) has not been satisfied.

Finally, a reasonable search of the compounds of Group I will include a search of Class 514, subclass 44. Accordingly it is not seen that a search of the two groups creates an undue burden upon the Examiner.

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CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 251-3509.

Respectfully submitted,

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